

Date	July 18, 2012	Court	Intellectual Property High Court, Second Division
Case number	2012 (Gyo-Ke) 10042		
– A case in which, with regard to the similarity between the plaintiff's design and the cited design both pertaining to a motorcycle tire, the Japan Patent Office (JPO) judged these designs to be similar to each other, while placing emphasis on the common feature in these designs, that is, three types of grooves, which appear to loosely constitute one unit, being aligned in a zigzag pattern and appearing repeatedly, whereas the court considered that taking the publicly known designs into consideration, said feature cannot alone be regarded as an essential part of the plaintiff's design but its essential part is the specific shape, etc. of the three types of grooves that repeatedly appear as a unit, and as a result of making a finding and comparison in terms of the aesthetic impressions arising from the specific shape, etc. of the three types of grooves in the respective designs, the court concluded that these designs are not similar to each other and rescinded the JPO decision.			

References:

Article 3, paragraph (1), item (iii) of the Design Act

1. The plaintiff filed an application for design registration and was given a decision by an examiner of the Japan Patent Office (JPO) to refuse the application on the grounds that the plaintiff's design was similar to the cited design (the design described in US Design Patent 09W41 of October 13, 2009 (US D601943S), accepted by the JPO, Information Dissemination and Policy Promotion Division, as of November 5, 2009). The plaintiff then filed a request for a trial against the examiner's decision of refusal and was given a decision by the JPO to dismiss the request. Accordingly, the plaintiff seeks rescission of the JPO's trial decision.
2. In its trial decision, the JPO judged the plaintiff's design and the cited design to be similar to each other, and explained the common feature between them as follows: “Both designs have a pattern consisting of three types of grooves, a long inclined groove, medium inclined groove, and short groove, which appear to loosely constitute one unit, and units of grooves are aligned in a zigzag pattern centering on the equator. This feature forms the keynote of both designs, and it gives a strong common impression to consumers and creates a common aesthetic impression on consumers upon seeing the designs. Thus, it has a dominant influence on consumers in judging the similarity between these designs.”
3. On the other hand, the court determined that these designs are not similar to each other on the grounds that even when this common feature is taken into consideration,

the plaintiff's design as a whole creates a different aesthetic impression than that created by the cited design in traders and consumers. More specifically, the court held as follows.

(1) Determination on the essential part

"Looking at the plaintiff's design as a whole, three types of grooves, i.e. long, medium, and short grooves, all of which are inclined in almost the same direction, constitute one unit, and units of grooves are aligned in a zigzag pattern centering on the equator and in a state inclined to the right and left. Taking into consideration the fact that multiple designs with this pattern had been registered in Japan and the United States prior to the filing of the application of the plaintiff's design, this pattern cannot alone be regarded as a characteristic feature of the design that can easily attract the attention of traders and consumers. Rather, in the case of the plaintiff's design, the specific shape, alignment and location of the three types of grooves that repeatedly appear as a unit, serve as a characteristic part (essential part) of the design that can easily attract the attention of traders and consumers."

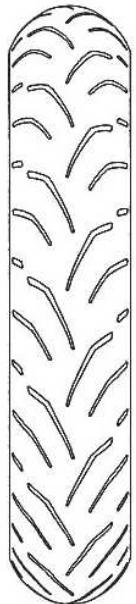
(2) Determination on the similarity between the designs

"The plaintiff's design as a whole gives such an impression that units of the three types of grooves are aligned regularly, at almost the same interval."

"The cited design, when observed in comparison with the plaintiff's design, also seems to have a pattern consisting of three types of grooves that constitute one unit. However, when observed alone, the cited design as a whole gives such an impression that three types of grooves are aligned at random or irregularly."

"In the case of the three types of grooves in the plaintiff's design, the groove edge is straight and the groove becomes slim toward the groove end. Because of these features, these grooves give people who see them such an aesthetic impression that one end of the groove is shaped with pointed thin lines, which makes the groove appear to be inorganic and very sharp and floating from the sidewall toward the equator. On the other hand, in the case of the three types of grooves in the cited design, partly because the groove width basically does not vary, these grooves give people who see them such an aesthetic impression that the groove in a uniform width is bent like a curved line, or more specifically, like cylindrical bacteria or cells with a blunt point aligned at random."

Backside of the plaintiff's design



Backside of the cited design (Fig. 2)

